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To: Commissioner for Patents for **Examiner John M. Winter** **Group Art Unit 3621**	Facsimile No.: **571/273-8300**
From: Jennifer Pilcher Legal Assistant to Wayne Bailey	No. of Pages Including Cover Sheet: **5**

Message:

Enclosed herewith:

- Transmittal of Reply Brief; and
- Reply Brief.

Re: Application No. **09/877,157**
Attorney Docket No: **RSW920000172US1**

Date: Friday, March 31, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Bleizeffer et al.**

Serial No.: **09/877,157**

Filed: **June 8, 2001**

For: **Interface for Creating Privacy Policies for the P3P Specification**

§ Group Art Unit: **3621**
§
§ Examiner: **Winter, John M.**
§
§ Attorney Docket No.: **RSW920000172US1**
§

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By: Jennifer Pilcher

TRANSMITTAL OF REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:
ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

Duke W. Yee
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Docket No. RSW920000172US1 *PATENT*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Bleizeffer et al.**	§	
	§	Group Art Unit: **3621**
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	§	Examiner: **Winter, John M.**
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	§	
For: **Interface for Creating Privacy Policies for the P3P Specification**	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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By: Jennifer Pilcher
Jennifer Pilcher

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on February 3, 2006.

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

ARGUMENT

A. Grouping of Claims

On page 2 of the Examiner's Answer, under Section (7) Grouping of Claims, the Examiner states "The Appellant's brief includes a statement that the claims stand or fall together". Appellants urge that this statement is incorrect, and Appellants have separately argued the following groupings of claims in the originally filed appeal brief:

Claims 1, 12 and 24 (separately argued under heading B.1)
Claims 4 and 15 (separately argued under heading B.2)
Claims 5 and 16 (separately argued under heading B.3)
Claims 6, 7, 17 and 18 (separately argued under heading B.4)
Claims 10 and 21 (separately argued under heading B.5)
Claims 11 and 22 (separately argued under heading B.6)
Claim 23 (separately argued under heading B.7)

B. 35 U.S.C. 103 Rejection

Claims 1, 12 and 24

In the Response to Argument section in the Examiner's Answer, under the heading "Second Issue" on page 7 of the Examiner's Answer, the Examiner characterizes Appellants' arguments as being *nonanalogous art* with respect to the two cited references. To the contrary, Appellants have argued that the Examiner has failed to properly establish a *prima facie showing of obviousness*, and Appellants have not argued that the cited references are *nonanalogous*. Quite simply, the Examiner has failed to establish any teaching or suggestion in any of the cited references of any method (Claim 1), apparatus (Claim 12) or computer program product (Claim 24) for creating a *privacy* policy. Because a proper prima facie case of obviousness has not been established, the burden has not shifted to Applicants to rebut the (improper) obviousness rejection. In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Claims 6, 7, 17 and 18

In the Response to Argument section in the Examiner's Answer, under the heading "Second Issue" on page 7 of the Examiner's Answer, the Examiner contends that the Applicant has made no formal challenge to the Official Notice taken in the prior rejections. Appellants urge that they in fact did make a formal challenge to the Examiner's position, and traversed the Examiner's position by stating that whether or not something is "well-known" is not a proper basis for an obviousness rejection. As recently articulated by the Federal Circuit in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.* (Fed Circuit Opinion 04-1493 dated June 9, 2005), inventions are typically new combinations of existing principals, and the invention should be considered *as a whole* and not broken down into component parts (each of which may be individually known). The Examiner did not consider the inventions of Claims 6, 7, 17 and 18 as a whole, but instead broke such claims into component pieces and alleged that each of the individual component pieces were well-known, which is error.

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